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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,676	10/08/2003	Daniel Peter Ivkovich JR.	125054/11901 (21635-0110)	7687
31450 7590 03/09/2007 MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166			EXAMINER MAZUMDAR, SONYA	
			ART UNIT 1734	PAPER NUMBER
			MAIL DATE 03/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/681,676

Applicant(s)

IVKOVICH ET AL.

Examiner

Sonya Mazumdar

Art Unit

1734

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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IVKOVICH

Continuation of 11. does NOT place the application in condition for allowance because:

In general response to all arguments, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

With respect to the arguments against the rejection of Ground 1 (see pages 7-8), Ross teaches a base with a water-soluble release coating (i.e. first release system) and an optical coating provided thereon. An intermediate surface with a general release coating (i.e. second release system) is attached to the base, on top of the optical coating, and when the base is removed, the optical coating is transferred to the intermediate surface. Although the dissolution properties of the second release system are not explicitly stated, two different release systems are taught in this transfer process. Therefore Ross's teachings read on the limitations of claims 1 and 23 and the rejection of claims 1 and 23, and claims 4 through 9, 15 and 24 accordingly, are maintained.

With respect to the arguments against the rejection of Ground 2 (see pages 9-13), in this case, Duchane et al. teach use of a water-soluble polyvinyl alcohol substrate carrying a metal foil (i.e. optical coating). Although the polyvinyl alcohol substrate is dissolved in addition to the teachings of Ross's release coating, the teachings of Duchane et al. still read upon the limitations of the claim; thus, claim 2 stands rejected.

With respect to the arguments against the rejection of Ground 3 (see pages 13-14), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shaul et al. teach use of release-coated aluminum foil, which can be specifically etched or dissolved away, in forming a laminate. Therefore, in combination with the teachings of Ross, the limitations of the claim are read upon, and claim 3 stands rejected.

With respect to the arguments against the rejection of Ground 4 (see pages 14-16), it is agreed that Ross does not teach such limitations set in claims 10 through 12. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). But in reference to a furnishing step of a specific article, Conolly teaches a step of furnishing a surface of an article, such as a component for a gas turbine engine, so it is ready to receive an optical coating. Therefore, in combination with the teachings of Ross, the limitations of the claims are read upon, and claims 10 through 12 stand rejected.

With respect to the arguments against the rejection of Ground 5 (see pages 16-19), Hankland teaches a method of transferring an optical coating from a carrier by means of an adhesive element (i.e. bonding element) as a component of an article and heating and pressing to effectuate transfer of the coating. This process takes place in an autoclave using a vacuum bag and a heat source. Also, because the metal coating, taught by Hankland, can be deposited by various methods (column 3, lines 43-53), it would have been obvious that the metal coating and a transfer substrate would be arranged in such a manner where each is affixed to the article surface. Therefore, in combination with the teachings of Ross, the limitations of the claims are read upon, and claims 13, 16-18, and 20 stand rejected.

With respect to the arguments against the rejection of Ground 6 (see pages 19-20), it is agreed that Ross does not teach such limitations set in claim 19. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). But in reference to an affixing step, Alexander teaches ironing a foil (22) onto a substrate (20), inherently with heat and pressure, and removing the foil's overlying carrier member to leave the foil on the substrate. Therefore, in combination with the teachings of Ross, the limitations of the claim are read upon, and claim 19 stands rejected.

With respect to the arguments against the rejection of Ground 7 (see pages 20-23), it is agreed that Ross does not teach such limitations set in claim 14. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). But in reference to an affixing step, Oliva teaches applying adhesive (i.e. bonding element) onto an article surface and adhering a metallic coating thereon. Therefore, in combination with the teachings of Ross, the limitations of the claim are read upon, and claim 14 stands rejected.

With respect to the arguments against the rejection of Ground 8 (see pages 23-26), the valid combination of Ross, Duchane et al., and Hankland were made in the above responses to arguments against the rejections of claims 1 and 13. Therefore, claims 21 and 22 stand rejected..